

REMARKS

In the Office Action, the Examiner rejected claims 2, 21, 23-26, 29 and 34-36 and objected to claims 30-33. By the present Response, the Applicants amended claims 2, 21, 23, 34, and 35 and canceled claims 27-28 and 30-33 to expedite allowance of the present application. In view of the foregoing amendments and the following remarks, the Applicants respectfully request reconsideration and allowance of all pending claims.

Restriction/Election Requirement

In the Office Action, the Examiner restricted the claims to one of two groups. Specifically, the Examiner provided the following groups: (group I) claims 27 and 28 drawn to holding segments in a rotary clamp, and (group II) claims 21, 23, 24, and 34-36 drawn to winding segments with a wire dispenser. The Examiner also indicated that claims 2, 25, 26, and 29 link the inventions of groups I and II. Finally, the Examiner noted that the Applicants constructively elected group II, because the Applicants already received an action on the merits for the originally present invention. Although the Applicants do not necessarily agree with the Examiner's reasons for restriction, the Applicants elect to prosecute the claims corresponding to group II and the linking claims.

Claim Objections

The Examiner objected to claims 30-33 under 37 C.F.R. § 1.75(c) as being of improper dependent form for failing to further limit the subject matter of the previous claim. Although the applicants do not necessarily agree with the Examiner's claim objections, the Applicants canceled claims 30-33 to expedite allowance of the present application.

Rejections Under 35 U.S.C. § 102

The Examiner rejected claims 2, 24, 25, 26, 29, 34, and 35 under 35 U.S.C. § 102(b) as anticipated by Shramo et al. (U.S. Patent No. 5,425,165). The Applicants respectfully traversed this rejection.

A *prima facie* case of anticipation under 35 U.S.C. § 102 requires a showing that each limitation of a claim is found in a single reference, practice or device. *In re Donohue*, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Independent Claim 2 and Depending Claims

Claim 2 recites, *inter alia*, “winding N sets of stator segments, each segment comprising a *respective, separate bobbin*.” In addition claim 2 recites, *inter alia*, “combining the N sets of segments in a common circumferentially adjacent circular arrangement to form the wound member, *maintaining the wire of each segment on the bobbin on which the wire was wound*.”

In contrast, the Shramo et al. reference discloses a *single* winding form 62 for coil segments of a coil winding 22, which is subsequently *removed* from the winding form 62 prior to incorporation into a cylindrical core 66. *See* Figs. 7, 10, and 11; Col. 9, lines 1-38. Thus, the Shramo et al. reference lacks a *respective, separate bobbin* for each of the coil segments of the coil winding 22. In addition, the Shramo et al. reference clearly fails to maintain the wire of each segment of the coil winding 22 on the winding form 62 on which the wire was wound. In view of these omitted claim features, the Shramo et al. reference cannot anticipate independent claim 2 and the claims depending therefrom.

For these reasons, the Applicants respectfully request the Examiner withdraw the rejections of independent claim 2 and its dependent claims under 35 U.S.C. § 102(b).

Independent Claim 23 and Depending Claims

Claim 23 recites, *inter alia*, “winding N sets of segments, each segment of the N sets of segments comprising a *respective, separate bobbin*.” In addition claim 23 recites, *inter alia*, “combining the N sets of segments in a common circumferentially adjacent arrangement to form the wound member, *maintaining the wire of each segment on the bobbin on which the wire was wound*.”

Again, as discussed above with reference to claim 2, the Shramo et al. reference contrastingly discloses a *single* winding form 62 for coil segments of a coil winding 22, which is subsequently *removed* from the winding form 62 prior to incorporation into a cylindrical core 66. *See* Figs. 7, 10, and 11; Col. 9, lines 1-38. Thus, the Shramo et al. reference lacks a *respective, separate bobbin* for each of the coil segments of the coil winding 22. In addition, the Shramo et al. reference clearly fails to *maintain* the wire of each segment of the coil winding 22 on the winding form 62 on which the wire was wound. In view of these omitted claim features, the Shramo et al. reference cannot anticipate independent claim 23 and the claims depending therefrom.

For these reasons, the Applicants respectfully request the Examiner withdraw the rejections of independent claim 23 and its dependent claims under 35 U.S.C. § 102(b).

Independent Claim 34 and Depending Claims

Turning to the final independent claim set, amended independent claim 34 recites:

A method of winding segment of a segmented wound member of an electromechanical device, comprising:

(A) Arranging a plurality of stator segments in a side-by-side orientation *along an axis of rotation*, each stator segment of the plurality of stator segments comprising a *respective, separate bobbin*; and

(B) winding a wire dispensed from a wire dispenser *permanently onto the bobbin* of each of the plurality of segments with respect to the axis of rotation such that the plurality of segments are electrically in series.

Again, as discussed above with reference to claims 2 and 23, the Shramo et al. reference contrastingly discloses a *single* winding form 62 for coil segments of a coil winding 22, which is subsequently *removed* from the winding form 62 prior to incorporation into a cylindrical core 66. *See* Figs. 7, 10, and 11; Col. 9, lines 1-38. Thus, the Shramo et al. reference lacks a *respective, separate* bobbin for each of the coil segments of the coil winding 22. In addition, the Shramo et al. reference clearly fails to provide *permanent* winding of wire on respective, separate bobbins, as recited in claim 34. Instead, the winding form 62 is flattened to facilitate removal of the coil winding 22. *See id.* In view of these omitted claim features, the Shramo et al. reference cannot anticipate independent claim 34 and the claims depending therefrom.

For these reasons, the Applicants respectfully request the Examiner withdraw the rejections of independent claim 34 and its dependent claims under 35 U.S.C. § 102(b).

Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 21 and 36 under 35 U.S.C. § 103(a) as unpatentable over Shramo et al. in view of JP '119. The Examiner also rejected claim 23 under 35 U.S.C. § 103(a) as unpatentable over Shramo et al. in view of JP '112. The Applicants respectfully traversed these rejections.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the

combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

As discussed in detail above, the Shramo et al. reference does not teach or suggest *respective, separate bobbins*, as recited in independent claims 2, 23, and 34. In addition, the Shramo et al. reference contrastingly *removes* the coil winding 22 from the winding form 64 prior to subsequent attachment to the cylindrical core 66. See Figs. 7, 10, and 11; Col. 9, lines 1-38.

The secondary references also fail to teach or suggest these omitted features. Turning to the first rejection, the Examiner cited JP '119 solely for its alleged teaching of a relative rotation with the segments rotating and the wire dispenser remaining stationary. See Paper 25, page 5. Turning to the second rejection, the Examiner cited JP '112 solely for its alleged teaching of "moving the wire dispenser in a direction parallel to the axis of rotation to a position adjacent the next segment,"

as recited in independent claim 23. However, the cited references do not obviate the deficiencies of Shramo et al. as discussed in detail above.

In addition, regarding the JP '119 and JP '112 references, the Applicants stress the impropriety of the Examiner's reliance on the abstract rather than the underlying document itself. *Ex parte Jones*, 62 U.S.P.Q.2d 1206 (PTO Bd. App. 2001). As noted by the Board of Patent Appeals and Interferences, the reliance on abstracts is problematic, because abstracts are often prone to erroneous or incomplete descriptions of the invention. "A proper examination under 37 C.F.R. § 1.104 should be based on the underlying documents and translations, where needed." *Id.*

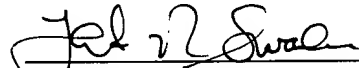
For these reasons, the Applicants respectfully request the Examiner withdraw the rejections under 35 U.S.C. § 103(a).

Conclusion

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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